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10/700,524	11/05/2003	Koubun Sakagami	R2184.0272/P272	5931
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DICKSTEIN SHAPIRO LLP 1825 EYE STREET NW Washington, DC 20006-5403			EXAMINER GOMA, TAWFIK A	
			ART UNIT 2627	PAPER NUMBER
			NOTIFICATION DATE 07/09/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

### **DETAILED ACTION**

This action is in response to the arguments filed on 6/02/2008.

#### ***Response to Arguments***

Applicant's arguments filed 6/02/2008 have been fully considered but they are not persuasive.

#### ***Response to Arguments***

Applicant's arguments filed 12/17/2007 have been fully considered but they are not persuasive. In response to applicant's argument that Fujitsa et al (US 5469420) does not remedy the deficiencies of Powerlson et al (US 6940790), because Fujitsa provides for the use of actual reproduction data in the evaluation as opposed to test data, the examiner respectfully disagrees. Powelson provides for the use of test data to be evaluated using a mean squared error evaluation, and the only deficiency of Powelson is the use of distribution of the test data in the evaluation process. Fujita discloses the use of a distribution in evaluation reproduction data curing the deficiency of Powelson, and one would have been motivated to make the combination for the reasons recited in the rejection above. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, the teachings of Fujitsa would have suggested to one of ordinary skill in the art at the time of the applicant's invention the use of a distribution analysis to determine if the test data of Powelson is normal.

In response to applicant's arguments that one of ordinary skill in the art would not have looked to Fujitsa because Fujitsa does not use test data during the analysis, "A person of ordinary skill in the art is also a person of ordinary creativity, not an automation." KSR, 550 U.S. at \_\_\_, 82 USPQ2d at 1397. "[I]n many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle."Id. Office personnel may also take into account "the inferences and creative steps that a person of ordinary skill in the art would employ."Id. at \_\_\_, 82 USPQ2d at 1396.

In response to applicant's arguments that the examiner has not applied the Graham factors in rejecting the claims under 35 U.S.C. 103, the examiner disagrees. It is unclear to the examiner which of the Graham factors applicant is contending have not been satisfied by the rejection. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The rejection properly applies the Graham factors by identifying what is disclosed in Powelson, identifying the deficiencies in Powelson, identifying what is disclosed in Fujitsa, resolving that one of ordinary skill in the art would be capable of combining the references and providing a proper motivation. The motivation for combining the references is provided in the rejection and is to use a distribution of the data in order to determine if the data is normal in order to compensate for single instances of abnormality which would skew the decision process of

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determining whether the data as a whole is normal. Applicant attacks the motivation provided by the examiner as an "unsupported statement," but fails to articulate any support for why the motivation is not proper for the combination of the references. (Applicant's arguments pages 11-12) "If an applicant disagrees with any factual findings by the Office, an effective traverse of a rejection based wholly or partially on such findings must include a reasoned statement explaining why the applicant believes the Office has erred substantively as to the factual findings. A mere statement or argument that the Office has not established a prima facie case of obviousness or that the Office's reliance on common knowledge is unsupported by documentary evidence will not be considered substantively adequate to rebut the rejection or an effective traverse of the rejection under 37 CFR 1.111(b)." (See MPEP 2141 section IV).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAWFIK GOMA whose telephone number is (571)272-4206. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tawfik Goma/  
Examiner, Art Unit 2627